

REMARKS

I. Petition for Extension of Time

Applicants herewith petition the Commissioner for Patents to extend the time for response to the Office action mailed 21 November 2005 for three (3) months from 21 February 21 2006 to 21 May 2006. Authorization is given to charge the extension of time fee of \$1,020.00 (37 C.F.R. §1.136 and §1.17) to Deposit Account No. 23-1703. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.

II. Examiner Interview

On behalf of the Applicants, the undersigned Attorney wishes to thank the Examiner for the courtesy of the Interview that took place on 15 February 2006. Applicants submit that the Interview Summary provides a complete written statement in satisfaction of 37 C.F.R. §1.133(b) as to the substance of the interview with regard to the merits of the subject application.

Specifically, the rejections of record were discussed. At the time of the interview, claims 1, 2, 14, 17 and 18 were pending. Claims 17 and 18 were rejected under 35 U.S.C. §112, second paragraph. All of the pending claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Lindberg (WO 94/27988) and Bergstrand (WO 96/01623). Claims 1, 2, 14 and 18 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 2, 11 and 12 of US 6,369,085 (the "085 patent").

At the interview, the Examiner clarified that the obviousness rejection applied to only composition claims 14 and 17 and method of treatment claim 18, but not to compound claims 1 and 2. Therefore, in view of this clarification and the cancellation herein of claims 14, 17 and 18, the rejections of record under 35 U.S.C. §§103 and 112 are moot. The only remaining rejection is the statutory double patenting rejection 35 U.S.C. §101 with respect to claims 1 and 2.

III. Claim Rejections – Double Patenting

Claims 1 and 2 are rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 2, 11 and 12 of the '085 patent.

The Examiner's attention is directed to original claims 1-3 of U.S. Patent Application 09/077,719 (the "719 application) from which the cited '085 patent issued:

- original claims 1 and 2 of the '719 application correspond to pending claims 1 and 2 of the subject application, and
- original claim 3 of the '719 application corresponds to claim 1 of the '085 patent.

Original claim 3 of the '719 application was dependent upon claim 1. Applicants submit that recognition by the Office that claim 3 would be allowable if rewritten in independent form to include the limitations of claim 1 is an acknowledgement by the Office that claim 3, now claim 1 of the '085 patent, is not identical to original claim 1 which remained rejected under 35 U.S.C. §103 (a) for obviousness. Thus, if the claims themselves are not identical, then the scope of original claim 3, now claim 1 of the '085 patent, and that of original claim 1 of the '719 application cannot be identical.

Patentability of the invention of original claim 1, and also original claim 2, of the '719 application is now the subject of this continuation. For the sake of fairness to Applicants and the public, the Office should be required to be consistent. The examination of the invention of original claim 1 of the '719 application in this continuation does not negate the precedent established by the Office: the scope of original claim 3, now claim 1 of the '085 patent, is different from, i.e., not identical to that of original claim 1 of the '719 application. *A fortiori*, the scope of original claim 3, now claim 1 of the '085 patent, cannot now be considered identical to that of pending claim 1 merely because patentability of the claimed invention is the subject of a continuation application.

Therefore, in view of the acknowledged difference in scope between original claim 3, now claim 1 of the '085 patent, and that of pending claim 1, there is no identity of invention within the meaning of §101. Furthermore, as discussed above, rewriting original claim 3 of the '719 application in independent form to include the limitations of claim 1 clearly establishes the relationship between claim 1 of the '085 patent and pending claim 1 as species and genus, respectively.


For all of the foregoing reasons, withdrawal of the §101 rejection is requested.

CONCLUSION

Applicants submit that claims 1 and 2 are in condition for allowance, which action is earnestly solicited. The Commissioner is hereby authorized to charge Deposit Account No. 23-1703 in the event that any fee is required in connection with this communication.

Dated: 19 May 2006

Respectfully submitted,



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